

REMARKS/ARGUMENTS

The Examiner has delineated the following inventions as being patentably distinct:

Group I: Claims 1-10 and 15-20, drawn to an organosilane based composition;

Group II: Claims 11-14, drawn to a method of making an organosilane based composition; and

Group III: Claim 21-24, drawn to packaging material.

Applicants provisionally elect with traverse the invention of Group I (Claims 1-10 and 15-20) drawn to an organosilane based composition.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinction. Unity of invention has to be considered in the first place only in relation to the independent claim. A dependent claim is one which contains all the features of another claim, and is in the same category of claims as other claims. It does not matter if a dependent claim, itself, contains a further invention. Moreover, when making a lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group (i.e., why there is no single inventive concept) specifically describing the unique special technical feature in each group (M.P.E.P. § 1893.03(d)).

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. The Examiner asserts that Groups I-III do not relate to a single inventive concept under PCT Rule 13.1 and 13.2 because they lack the same corresponding special technical feature.

The Examiner has not considered that the claims in each group are considered to have related invention under 37 C.F.R. § 1.475(b) in which the inventions are considered to have

unity of invention. Applicants submit that while PCT 13.1 and 13.2 are applicable, 37 C.F.R. § 1.475(b) provides in relevant part that “a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to --(3) a product, process specially adapted for the manufacture of said product, and use of said product.

As the Office has not shown that a restriction should now be required when the International Examination Report did not, restriction is believed to be improper.

Further, the M.P.E.P. § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

Applicants request that if the invention of Group I is found allowable, withdrawn Groups II-III which include the limitations of the allowable claims be rejoined M.P.E.P. § 821.04.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

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